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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,876	04/13/2000	Jason D. Miller	0-03A	7633

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HANLEY, FLIGHT & ZIMMERMAN, LLC
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EXAMINER

HORTON, YVONNE MICHELE

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/548,876

Applicant(s)

MILLER ET AL

Examiner

Yvonne M. Horton

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-17,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-11 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,12-17,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All . b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/2/04 & 11/22/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Finality of the last Office action is being withdrawn.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,2,4-8,14,16,17,20 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-5,8,12,17 of copending Application No. 10/369,973. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a dock pad extending horizontally and consisting of a foam core with a cover disposed thereover and a heat shield interposed between the cover and the core; wherein the heat shield is made of

aluminum and has a higher thermal conductivity than the cover and can withstand a higher temperature than the core and the cover.

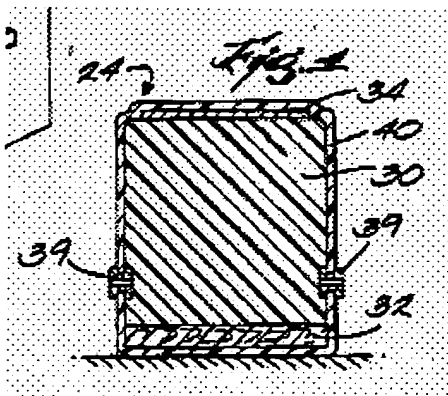
Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,2,4-7,12-15,17,19 and 20 are rejected under 35 USC 103(A) as being unpatentable over US Patent #6,016,637 to STYBA. Regarding claims 1,7,17 and 20, STYBA discloses the use of a sealing curtain (10) adapted to seal against a parked vehicle (22) including a sealing surface (40) and a shield (34) adjacent the sealing surface (40) wherein the shield (34) is typically made from man made materials such as nylon or polyester and sealing surface (40) that is a flexible liquid cured urethane such as vinyl. Wherein, due to the known characteristics of nylon or polyester and vinyl, the shield (34) and the sealing surfaces are known as being pliable. The shield (34), which is an inner layer, being a nylon or polyester material, is commonly known in the art as having the ability to shield a certain amount of heat and has thermal conductivity of 0.01-0.48k which is higher than the thermal conductivity of the urethane sealing surface which is the outer layer and that is known as 0.017k. Hence, similarly to applicant's invention, the inner layer (34) has a higher thermal conductivity than the outer layer (40). STYBA discloses the basic claimed sealing curtain except for explicitly detailing

the thermal conductivity of his inner and outer layers (i.e. the sealing and heat surfaces). Although STYBA is silent in this regard, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a known material on the basis of its suitability for the use intended. For instance, if it was important to stop the transfer of heat from an outer layer to an inner layer, the outer layer might be formed from a material having a higher thermal conductivity than the inner layer. Whereas, if it was not important that there be any heat transmission between layers, the choice of material would not be of concern as far as resisting heat. Regarding claim 2, the sealing curtain (10) has an inner surface (IS), see below, wherein the shield (34) is interposed between the inner surface (IS) and the sealing surface (40), see the attached exhibit. In reference to claim 3, the shield (34), being nylon or polyester, has thermal conductivity of 0.01-0.48k, which is higher than the thermal conductivity of the inner surface (IS), which is polyurethane and has a thermal conductivity of 0.17k. Regarding claims 4,7 and 18, because the shield (34) has a higher thermal conductivity, the shield (34) can withstand higher temperatures than the inner surface (IS) and the sealing surface (40).



In reference to claim 12, Styba discloses a backer (32) attached to the cover (40). The backer (32) is wood and knowingly has a greater rigidity than the foam core (30). The backer (32) serves to provide the foam core (30) and the cover (40) with structural support. In regards to claim 13, in Figure 4 below, Styba discloses a sealing surface and a mounting surface (MS) that face away from each other with at least a portion of the heat shield (34) extending substantially parallel to the sealing surface and being closer to the sealing surface than the mounting surface (MS), wherein the sealing surface is adapted to seal against the vehicle and the mounting surface (MS) is adapted to be attached to a wall (16). (See above). In regards to claim 14, Styba discloses the dock pad (10) having an elongated length (20) running substantially horizontally. In regards to claim 15, Styba discloses the dock pad (10) having an inverted "U-shape" with one horizontally elongated member (20) and two vertically elongated members (18, 18'), with the heat shield (34) being part of the horizontally elongated member (20). Regarding claim 19, again, Styba is not explicit as the flexibility of the materials of his dock seal. However, he does disclose in column 2, lines 41-52 that his dock seal has the ability to "compress" in response to a vehicle coming in contact therewith. Styba further details, column 2, lines 53 to column 3, line 2, that the core (30) of his dock seal is "resilient". A resilient material has the ability to regain its original shape. Hence, inherently, the material of the heat shield (34) must be capable of enough flexibility to allow the core (30) to compress and return to its original shape.

Allowable Subject Matter

Claims 7-11 remain as being allowed.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the newly revised ground(s) of rejection; however, the examiner has still addressed the arguments with respect to the last Official Arguments and other arguments from previous Actions not addressed.

In regards to the applicant's argument that there is no mention of any thermal properties in STYBA '637, the examiner agrees. However, STYBA does disclose the type of materials used for his different layers. Thus, these materials each possess their own commonly known physical characteristics or attributes as can be seen on several generalized or standardized charts such as the "Transmission of Heat" chart provided by the examiner and the chart provided by the applicant in response to the last Official Action. Although the claims do not specify a certain numerical value desired for the thermal conductivity, both of the charts provided show that there is in fact a "thermal conductivity" associated with various materials. One of ordinary skill can refer to these charts for reliable characteristics for certain materials. Hence, in the rejections noted above, since the specific material was disclosed, the thermal conductivity was obtained using a standardized chart, as mentioned earlier.

In reference to the applicant's argument that the layer referred to by the examiner as being a "heat" layer is merely a puncture resistant layer, even though the examiner agrees that the layer is a puncture layer, due to the physical properties possessed by the material, the material is also capable of having a thermal conductivity. Just because

the material is puncture resistant does not exclude the fact that it can also have a thermal conductivity.

As argued by the applicant, and the examiner agrees, that similar or the same materials or materials have the same name may comprise or be made up of different elements that cause the materials having a similar name to take on different characteristics such as have a different thermal conductivity. For instance, aluminum, on the "Transmission of Heat" chart can have a thermal conductivity of 1160.00 k or 960.00 k; Polyester can have a thermal conductivity of 0.48 k or 0.31 k; polystyrene has a thermal conductivity of 0.21 k or 0.28 k and BARRIER 20 has a thermal conductivity of 0,05 k or 0.037 k. Thus, it stands that the elements used to compose the materials may be different and may cause the materials to have different characteristics and/or perform differently. Hence, it remains that the selection of a material is suitable for the use intended as an obvious matter of design choice. It still remains that it would have been obvious to one having ordinary skill in the art to select a heat shield having a higher thermal conductivity than the sealing surface in order to properly disperse and/or control the heat subjected throughout. Perhaps if the heat shield is used in an area where the vehicles are much smaller and might have less heat dissipated from the tail lights, a material having less thermal conductivity would deem appropriate. Whereas, a heat shield used in an area known for a high volume of vehicles known to dissipate a larger volume of heat, a material with a higher thermal conductivity would appear to be suitable.

Regarding the applicant's argument that the material of STYBA is used for puncture resistance, this may be true; however, due to the material make-up, the same material may serve several different functions; and apparently nylon/polyester, according to the "Transmission of Heat" chart provided, has the ability to conduct heat of some sort. In response to applicant's argument that the puncture resistant material () of STYBA is not used for thermal conductivity, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. The fact that the material of STYBA is puncture resistant does not negate the fact that this same material can carry out the function specified in the claim although not intended as such.

Again, in reference to the applicant's about material properties, the examiner agrees that certain materials have different ingredients that contribute to that materials thermal conductivity; however, without there being a specific or certain thermal conductivity or material cited in the claim language, the claims can only be examined in the broadest sense – as an inner layer having a thermal conductivity higher than an outer layer. The examiner did not suggest that all materials within a same class must possess the same thermal conductivity, her rejections were directed to specific materials, again merely due to the fact that STYBA '637 did not detail thermal conductivity. STYBA '637 only introduced materials and a standard chart was used to generate the

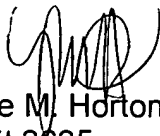
thermal conductivity for the material. This is common practice in the field. A material is given, and a chart is consulted in order to obtain certain characteristics of that material.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (571) 272-6845. The examiner can normally be reached on 6:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Yvonne M. Horton
Art Unit 3635
8/8/05